

REMARKS

Formal Matters

Claims 52 and 54 are pending in the instant application. Claim 52 has been amended and Claim 55 has been added. The support for the amendment of Claim 52 can be found, for example, but not limited by, in paragraphs 37, 54, and 71. The support for new Claim 55 can be found, for example, but not limited by, paragraph 37. No new matter has been added.

In view of the following remarks, Applicants respectfully request reconsideration of Claims 52, 54, and 55, the only claims under examination in the instant application.

Claim Rejections- 35 U.S.C. § 103(a)

In the Office Action dated Sept. 20, 2007, the Examiner rejected Claim 52 as allegedly obvious over Rochte et al. (US 3,545,690, filing date Jan. 22, 1968; hereafter Rochte) in view of Wheatcroft (CA 2,255,850, filing date Dec. 7, 1998). Additionally, Claim 52 and 54 under 35 U.S.C. § 103(a) were rejected as allegedly obvious over Rochte in view of Wheatcroft, and in further view of Woudenberg, et al. (US 5,928,907, filing date Dec. 2, 1996; hereafter Woudenberg).

In the Action, remarks are entered regarding the Applicant's Response dated July 3, 2007; which remarks the Applicant respectfully traverses. For example, it is stated that the arguments were entered for the references individually. As clearly stated in the Response dated July 3, 2007, the cited references fail to provide the necessary motivation; which motivation cannot be found either in the references alone, or in combination. As stated in the M.P.E.P. 2143.01, with respect to *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004):

The court emphasized that the proper inquiry is "whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination,' not whether there is something in the prior art as a whole to suggest that the combination is the most desirable combination available."

The Applicant maintains that, for example, the failure of Rochte to provide any desirability as a prior art reference for the instant application would provide no motivation to combine with another reference, for example, such as Wheatcroft.

However, the Applicant further respectfully submits that, given the nature of the amendment to Claim 52, that the cited references are moot. Unlike the cited art references, embodiments of methods of the instant application teach the use of a thermal cycler for performing nucleic acid amplification, which thermal cycler provides horizontal translation of the sample tray into and out of thermal cycler. Such horizontal translation of the sample tray into and out of the thermal cycler affords the end user with an instrument having a smaller footprint, which is a desirable attribute for today's laboratory. Additionally, the horizontal translation of the sample tray obviates the user from having to access the interior of the instrument to change the sample well tray. Such access to the interior of a device, system or apparatus for changing the sample well tray may only be cumbersome, but may create additional problems with respect to break down, and disrupted use.

None of these advantages are taught or suggested by the cited art references, and moreover is only provided by embodiments of methods of the instant application for performing nucleic acid amplification. Accordingly, the Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

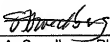
The Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact me at the telephone number listed below.

Fee Authorization

Should any extension of time and/or fee be necessary for the timely submission of this paper, such extension of time is hereby requested, and the Commissioner is hereby authorized to charge **Deposit Account No. 01-2213 (order no. 4696C1)**. Any deficiency or overpayment should be charged or credited to this deposit account.

Respectfully submitted,

Date: October 26, 2007



Sally A. Swedberg, Ph.D.
Reg. No. 53,659
Agent for Applicants

CORRESPONDENCE ADDRESS

Customer Number: 22896
APPLERA CORPORATION
Applied Biosystems Group
Patent Department – M/S 432-2
850 Lincoln Centre Drive
Foster City, California 94404
TEL: 650-554-2863
FAX: 650-638-6677